

REMARKS

Claims 1-33 and 35-41 are now pending in the present application. A petition and fee for a one-month extension of time is attached. The allowability of claims 2, 4, 5, 14, 15, 17, 19, 21 and 33 is gratefully acknowledged. Reconsideration of the remaining claims is respectfully requested in light of the amendments and remarks as included herein.

REJECTIONS UNDER 35 U.S.C. §112:

Claim 16 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Claim 16 has been amended in accordance with the rejections as set forth by the Examiner.

REJECTIONS UNDER 35 U.S.C. §102:

Claims 1, 3, 18, 20, 26, 27, and 35 were rejected under 35 U.S.C. §102(b) as being anticipated by Spiegel et al., U.S. Patent No. 4,530,542. Claim 1 defines a composite wheel that comprises, among other things, a wheel cladding including at least one support post extending from an inner surface of the wheel cladding proximate a hub aperture of a wheel and structurally supporting the wheel cladding with respect to the wheel. Applicants find no such structure disclosed by Spiegel et al. Specifically, careful inspection of Fig. 4 of the cited Spiegel reference shows that the cylindrical flange 26 and the peripheral flange 30 are in fact spaced in an axial direction from the outer surface of the associated wheel, and as a result, do not structurally support the wheel cladding with respect to the wheel. Therefore, Spiegel et al. cannot anticipate claim 1.

Accordingly, claim 1 is in condition for allowance. Claims 2-5 and 36 are dependent from claim 1, which is in condition for allowance, and are therefore also in condition for allowance.

Independent claims 18, 26 and 35 each include limitations similar to those as noted above with respect to claim 1, and are therefore allowable over Spiegel et al. for those reasons as set forth above and in condition for allowance. Claims 19-21 and 38,

claims 27 and 39, and claim 41 are dependent from independent claims 18, 26 and 35, respectively, which are in condition for allowance, and are therefore also in condition for allowance.

REJECTIONS UNDER 35 U.S.C. §103:

Claims 6-13, 16, 22-25 and 28-32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Spiegel et al. in view of Van Houten et al., U.S. Patent No. 6,779,852. Van Houten et al. fails to disclose that which is lacking from Spiegel et al. as noted above with respect to independent claims 1 and 18. Therefore, claim 6-9 and 22-25 are allowable as they depend from independent claims 1 and 18, respective, which are in condition for allowance as noted above.

Independent claim 10 defines a wheel cladding assembly that comprises, among other things, a body member adapted to conform to an outer surface of a wheel, and the body member having an exposed outer surface, an inner surface and a plurality of circumferentially-spaced lug apertures, and including at least one alignment tab extending from the inner surface and located radially inward of the lug apertures for engaging a hub aperture essentially located within a wheel and adapted to align the body member with respect to the hub aperture, and a centrally-located aperture, and a cap member located within the central aperture of the wheel cladding and operably connected to the wheel cladding.

It is well established that in order to find an invention obvious in light of a combination of references, there must be something present in the teachings of those references to suggest the claimed invention to one skilled in the art. *W.L. Gore and Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983) (citing *In re Bergel*, 292 Fd.2d 955, 956-57, 130 U.S.P.Q. 206, 208 (CCPA 1961)). Further, the mere fact that prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 Fd.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992) (citing *In re Gordon*, 733 Fd.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)). Moreover, it is improper to pick and choose among the

individual elements of assorted prior art references to recreate the claimed invention. *Smith Kline Diagnostics v. Helena Lab. Corp.*, 859 F.2d 878, 887, 8 U.S.P.Q.2d 1468, 1475 (Fed. Circuit 1988). Virtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law, under the statute §103. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1575, 1 U.S.P.Q. 2d 1593, 1603 (Fed. Cir. 1987).

Applicants contend that a prima facie case for obviousness has not been set forth. Specifically, the motivation for combining that which is taught in Spiegel with that which is taught by Van Houten et al. was set forth as "it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the wheel cladding of Spiegel et al. with a cap member of the configuration taught by Van Houten et al. for purposes of protecting the entire outer surface of the wheel assembly (including the hub aperture), thus preventing damage to the outer surface of the wheel and preventing debris from entering the hub aperture." Applicants contend that neither of these references actually set forth such motivation in and of themselves. Further, the cap structure as disclosed by Van Houten et al. is simply incompatible with the wheel cover and wheel as disclosed by Spiegel et al. Specifically, Van Houten et al. discloses cooperating sets of snap tabs and standoffs in order to engage the hub cap as disclosed therein with the wheel assembly. However, there is no such structure within Spiegel et al. to which to attach the snap tabs and the associated standoffs. Further, it is noted that the inner flange as disclosed by Spiegel et al. is adapted to specifically allow for form fitting of the cover with the associated wheel, thereby negating any significant changes to a structure that would be considered allowable under an obvious-type rejection.

Accordingly, claim 10 is in condition for allowance. Claims 11-17 and 37 are dependent from claim 10 which is in condition for allowance, as noted above, and are therefore also in condition for allowance.

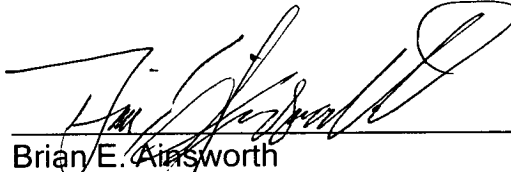
Applicant : Philip O. Gerard
Appln. No. : 10/689,229
Page -12-

Claim 28 defines similar limitations to those discussed above with respect to claim 10, and is therefore also in condition for allowance for those reasons as noted above. Claims 29-33 and 40 are dependent from claim 28 which is in condition for allowance, as noted above, and are therefore also in condition for allowance. Accordingly, claims 1-33 and 35-41 are in condition for allowance, and a Notice of Allowability is earnestly solicited.

Respectfully submitted,

By: Price, Heneveld, Cooper,
DeWitt & Litton, LLP

Dated: May 24, 2006



Brian E. Ainsworth
Registration No. 45 808
695 Kenmoor, S.E.
Post Office Box 2567
Grand Rapids, Michigan 49501
(616) 949-9610

BEA:kjc